

Appl. No. 09/996,512  
Amdt. Dated June 9, 2005  
Reply to Office action of April 15, 2005  
Attorney Docket No. P14165-US2  
EUS/JP/05-1159

### **REMARKS/ARGUMENTS**

#### **1.) Claim Amendments**

The Applicant has amended claims 5-7; no new matter has been added. Claims 1-7 remain pending in the application. Favorable reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

#### **2.) Examiner Objections - Claims**

The Examiner objected to claims 5-7 because of certain informalities. The Applicant has amended the claims as suggested by the Examiner. The Examiner's reconsideration of the amended claims is respectfully requested.

#### **3.) Claim Rejections - 35 U.S.C. §112**

The Examiner rejected claims 6-7 as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. Specifically, the Examiner stated that, in claim 6, it is not clear whether "a set of identifying parameters" refers to the "set of identifying parameters" recited in claim 1 or a second set of identifying parameters. Claim 6 has been amended to confirm the antecedent basis of that limitation as being the set of identifying parameters recited in claim 1. The Examiner's reconsideration of the amended claim is respectfully requested.

#### **4.) Claim Rejections – 35 U.S.C. §102(e)**

The Examiner rejected claims 1-4 and 6-7 as being anticipated by Iseyma (US 6,192,232). The Applicants traverse the rejections.

Anticipation requires that the disclosure of a single piece of prior art reveal every element, or limitation, of a claimed invention. Furthermore, the limitations that must be met by an anticipatory reference are those set forth in each statement of function in a claims limitations, and such a limitation cannot be met by an element in a reference that performs a different function, even though it may be part of a device embodying the same general overall concept. Iseyma fails to teach each limitation of the rejected

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claims and, therefore, the Applicant traverses the rejection of each of those claims as being anticipated.

Claim 1 recites:

1. A method in a communication system of transferring control of a user-plane entity from a first control-plane entity to a second control-plane entity, comprising the steps of:

sending, by the user-plane entity to the first control-plane entity, a set of identifying parameters;

sending, by the first control-plane entity to the second control-plane entity, the set of identifying parameters;

determining, in the second control-plane entity, whether the user-plane entity can be controlled by the second control-plane entity; and

if the user-plane entity can be controlled by the second control-plane entity, then sending, by the second control-plane entity to the user-plane entity, an indication that a change in control-plane entities has occurred and that at least some resources of the user-plane entity that were controlled by the first control-plane entity are to be controlled by the second control-plane entity. (emphasis added)

First, with respect to the limitation of claim 1 for "sending, by the user-plane entity to the first control plane entity, a set of identifying parameters," the Examiner asserts that Iseyma discloses such limitation at column 8, line 54 to column 9, line 12. The Applicants have reviewed Iseyma, particularly that portion, and find no teaching regarding the sending of a set of identifying parameters between a user-plane entity and a control-plane entity. Second, with respect to the claim limitation "sending, by the first control-plane entity to the second control-plane entity, the set of identifying parameters," the Examiner asserts that Iseyma discloses such limitation at column 1, line 59, to column 2, line 15. The Applicants have reviewed Iseyma, particularly that portion, and find no teaching regarding the sending of a set of identifying parameters between a first control-plane entity and a second control-plane entity. Rather, Iseyma there describes a first base station requesting a second base station to make a radio connection in response to a request for an emergency call. The Examiner has stated no basis for equating that teaching of Iseyma to the claimed limitation. Third, with respect to the claim limitation "determining, in the second control-plane entity, whether the user-plane entity can be controlled by the second control-plane entity," the Examiner asserts that

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Iseyma discloses such limitation at column 6, lines 17-22, and column 10, lines 17-23. The Applicants have reviewed Iseyma, particularly that portion, and find no teaching regarding determining, in a second control-plane entity, whether a user-plane entity can be controlled by a second control-plane entity. Rather, Iseyma there describes a base station controller sending a message to a mobile station indicating that the assignment of an idle radio channel is completed and that a handoff can be completed. The Examiner has stated no basis for equating that teaching of Iseyma to the claimed limitation. Accordingly, for the foregoing reasons, the Examiner has not established a prima face case of anticipation of claim 1. Furthermore, whereas claims 2-7 are dependent from claim 1, and include the limitations thereof, those claims are also not anticipated by Iseyma.

Furthermore, with respect to claims 2, 3 and 7, the Examiner asserts that Iseyma discloses "the first control-plane entity sends the set of identifying parameters to the second control-plane entity based on a location of a remote terminal in communication with the user-plane entity" and "the first control-plane entity sends the set of identifying parameters to the second control-plane entity based on a status of the first control-plane entity" at column 5, lines 35-61. The Applicants have reviewed Iseyma, particularly that portion, and find no such teaching of those claim limitations. Rather, Iseyma there describes sending a message requesting handoff if a mobile station changes its service zone. The Examiner has stated no basis for equating that teaching of Iseyma to the claimed limitations. Therefore, the Examiner has not established a prima face case of anticipation of claims 2, 3 or 7.

Furthermore, with respect to claim 4, the Examiner asserts that Iseyma discloses "the first control-plane entity sends the set of identifying parameters to the second control-plane entity based on relative loads in the first and second control-plane entities" at column 16, lines 23-26. The Applicants have reviewed Iseyma, particularly that portion, and find no teaching regarding the sending of a set of identifying parameters to a second control-plane entity based on relative loads in first and second control-plane entities. Rather, Iseyma there describes maintaining an emergency call even when a mobile station moves into a service zone with congested radio channels. The Examiner

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has stated no basis for equating that teaching of Iseyma to the claimed limitation. Therefore, the Examiner has not established a *prima face* case of anticipation of claim 4.

Furthermore, with respect to claim 6, the Examiner asserts that Iseyma discloses the claimed limitation at column 6, lines 16-36. The Applicants have reviewed Iseyma, particularly that portion, and find no teaching wherein the sending of a set of identifying parameters, by a user-plane entity to a first control-plane entity, is executed in response to receiving, by the user-plane entity, an indication that a change of control-plane entity is required. Rather, Iseyma there describes a handoff procedure for a mobile station. The Examiner has stated no basis for equating that teaching of Iseyma to the claimed limitation. Therefore, the Examiner has not established a *prima face* case of anticipation of claim 6.

**5.) Claim Rejections – 35 U.S.C. §103(a)**

The Examiner rejected claim 5 as being unpatentable over Iseyma in view of Boudreaux (US 6,466,556). As established hereinabove, claim 1 is not anticipated by Iseyma. Likewise, Boudreaux fails to cure the deficiencies of Iseyma and, thus, claim 1 is not obvious over Iseyma in view of Boudreaux. Therefore, claim 5, which is dependent from claim 1 and includes the limitations thereof, is also not obvious in view of those references.

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### CONCLUSION

In view of the foregoing amendments and remarks, the Applicants believe all of the claims currently pending in the Application to be in a condition for allowance. The Applicants, therefore, respectfully request that the Examiner withdraw all rejections and issue a Notice of Allowance for claims 1-7.

The Applicants request a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,



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